

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 37-43, 45-54, 56-65, 67-69, 97, and 98 are pending in the present application, Claims 37, 40, 48, 51, 59, 62, and 97 having been amended, and Claim 98 having been added. Support for the amendments to Claims 37, 48, 59, and 97 is found, for example, in paragraphs [0086]-[00124] and [1072] of the published version of the application (2002/0046097), and Figs. 7 and 8. Support for the amendments to Claim 40, 51, and 62 is found, for example, in Fig. 47. Support for new Claim 98 is found, for example, in Fig. 8 and paragraphs [0108] to [0110]. Applicants respectfully submit that no new matter is added.

In the outstanding Office Action, Claims 37-43, 45-54, 56-65, 67-69, and 97 were rejected under 35 U.S.C. §103(a) as unpatentable over Logan et al. (U.S. Patent No. 5,721,827, hereinafter Logan).

With respect to the rejection of Claim 37 as unpatentable over Logan, Applicants respectfully submit that the amendment to Claim 1 overcomes this ground of rejection.

Amended Claim 1 recites, *inter alia*,

registering means for receiving first predetermined information of a content creator and for storing the first predetermined information; [and]

receiving means for receiving from a personal computer of the content creator via internet, content data and second predetermined information including at least category information indicating genre of the content data, created by the content creator, which is appointed by the personal computer of the content creator after the personal computer of the content provider is authenticated based on the first predetermined information, the content data including advertising data affixed thereto, said advertising data being affixed based on commercial desired data generated in response to a selection by the content creator.

Logan does not disclose or suggest these elements of amended Claim 37.

Initially, Applicants note that the outstanding Office Action takes the position that “content creator” is vague. Applicants respectfully note that the plain meaning of “content creator” is the creator of the content. The present specification uses both “content creator” and “content provider.” Paragraph [0098] of the published version of the specification defines “content provider” as an internet service provider and an application service provider. While the specification does not expressly assign a definition to “content creator,” the usage of both “content creator” and “content provider” in the specification shows that these phrases have different meanings.

While it is well established that while the PTO is to give claim language its broadest “reasonable” interpretation, this does not mean that the PTO can completely ignore the understanding that the artisan would have of the terms “content provider” and “content creator” obtained in light of the specification so as to ascribe a completely different and unknown meaning to these terms. See In re Cortright, 165 F.3d 1353, 1358, 49 USPQ 2d 1464, 1467 (Fed. Cir. 1999). (“Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one those skilled in the art would reach.”) and In re Okuzawa, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976) citing In re Royka, 490 F.2d 981, 984, 180 USPQ 580, 582-83 (CCPA 1974) (“Claims are not to be read in a vacuum, and while it is true they are given the broadest *reasonable* interpretation during prosecution, their terms still have to be given the meaning called for by the specification of which they form a part.”). Thus, “content creator” should not be construed to have the same meaning as “content provider.”

Logan describes two devices, a host computer 101 and an audio player device 103. Logan describes a distribution system in which the host computer provides an audio program segment capable of including advertising materials to the audio player of a client subscriber.

Logan discloses that audio play device 103 may be a laptop or desktop personal computer. However, audio player device 103 is not the content creator. Audio player device does not create the audio content. It appears that the Office agrees with the Applicants because the outstanding Office Action relies on inherency to show the claimed "content creator," and does not assert that audio player 103 is the device of the content creator.

Furthermore, Applicants note that the subscribers discussed in Logan do not equate to the content provider. Rather, the subscribers discussed in Logan correspond to users who view, reproduce, or otherwise playback the content.

The outstanding Office Action takes the position that there is inherently a device that supplies the content. Applicants respectfully submit that the amendment to Claim 37 overcomes this ground of rejection. Claim 37 is amended to recite that the content is received from a personal computer of the content creator. Thus, Claim 37 cannot be interpreted as having the content be received from "any device." Logan does not disclose or suggest that the content data is from a personal computer of a content creator. Applicants respectfully submit that this deficiency in Logan cannot be overcome by asserting inherency.

Applicant respectfully submits that the assertion of inherency is insufficient to show that Logan inherently teaches the content is received from a personal computer of the content creator. Such a characteristic does not necessarily flow from the teachings of Logan.¹

"The fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic."² "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the

¹See MPEP 2112 (emphasis in original) (citation omitted). See also same section stating that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic," (emphasis in original). See also In re Robertson, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) ("[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill,'" citing Continental Can Co. v. Monsanto Co., 948 F2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991); and "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient," Id. at 1269 (citation omitted)).

² In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1995, 1957 (Fed. Cir. 1993).

thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”³

Further, the invention defined by Claim 37, the content creator must register with a service in advance of being able to transmit the content. Particularly, Claim 37 recites “registering means for receiving first predetermined information of a content creator...[and] receiving means for receiving from a personal computer of the content creator via internet, content data created by the content creator...which is appointed after the personal computer of the content creator is authenticated based on the first predetermined information.” Logan does not disclose or suggest authenticating the personal computer of the content creator.

In view of the above-noted distinctions, Applicants respectfully submit that Claim 37 (and any claims dependent thereon) patentably distinguishes over Logan. Claims 48, 59, and 97 recite elements that are analogous to the elements of Claim 37. Thus, Applicants respectfully submit that Claims 48, 59, and 97 (and any claims dependent thereon) patentably distinguish over Logan.

Moreover, Claims 40, 51, and 62 are amended to clarify what is meant by profit. The royalty payment in Logan is not calculated in accordance with the description added to Claims 40, 51, and 62. The formula in col. 20 of Logan does not take into account the connection fee of an internet service provider and a service fee of an application service provider, wherein the internet service provider connects the personal computer of the content provider to the Internet and the application service provider stores the content data. The formula in col. 20 of Logan also does not subtract the amount of money that corresponds to the number of times the content data created by the content creator was accessed by users of the

³ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

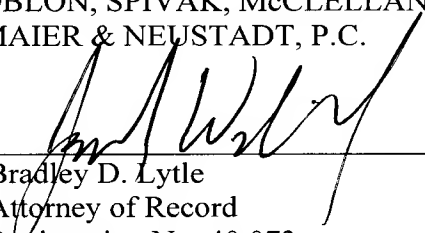
application service provider from the service user charges to determine the share of profits to be earned by the content creator.

Moreover, Applicants respectfully submit that new Claim 98 further patentably distinguishes over Logan. Logan does not disclose or suggest the further description of the registering means in Claim 98.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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